

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the above amendments and following remarks, which place the application into condition for allowance.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-12, 14-26 and 28-47 are pending in this application. Claims 5, 7-12, 19, 21-26 and 29-47 have been withdrawn from consideration. Claims 1-4, 6, 14-18, 20 and 28 are rejected in the Final Office Action mailed July 11, 2006. By this Supplemental Amendment, claims 15 is amended as indicated above. It is believed that no new subject matter is added as a result of the amended claims.

In addition to the arguments presented in the “Amendment and Petition for a Two-Month Extension of Time Submitted With a Request for Continued Examination” mailed to the USPTO on December 11, 2006 (“the previous Amendment”), please consider the following.

As discussed in the previous Amendment, the instant claims are specifically limited to papermaking fabrics, endless industrial fabrics and the multilayer filaments used to construct the fabrics. Papermaking and industrial fabrics are very specific in their use and are used in industrial applications on large machines under harsh, adverse conditions. Papermaking and industrial fabrics are not cut resistant apparel as is the case with U.S. Patent No. 6,033,779 to Andrews (“Andrews”) or protective clothing or gear such as a glove as is the case with U.S. Patent No. 5,685,014 to Dapsalmon (“Dapsalmon”), both of which are subject to less strenuous conditions and applications than papermaking and industrial fabrics. A skilled worker would not look to protective clothing as being applicable to the field of papermaking and industrial fabrics.

This is not a mere intended use. This is a specific article. Without it, the claim would be lacking in meaning.

This situation is analogous to that in *Corning Glass Works v. Sumitomo Electric*, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989). In that case the court held that the use of the term "optical waveguide" did not merely state a purpose or intended use. Rather, it gave "life and meaning" to the claim and provided a further positive limitation to the invention claimed. The court, in making its determination, looked to the entire patent to determine and gain an understanding as to what the inventors actually invented and intended to encompass by the claim. The court noted that "[t]o read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality."

So to here, to read the claim language to cover all types of fabrics would be divorced from reality. It is clear from the specification that the invention is directed towards papermaking and industrial fabrics. The environments in which these fabrics are used are much harsher and therefore require more durable fabrics than fabrics used in protective clothing. Papermaking and industrial fabrics must be able to withstand the ravages of the industrial machinery on which they are used. Accordingly, a skilled worker would not look to fabrics for use in an article of clothing as being applicable to papermaking and industrial fabrics. This is not a mere intended use. This is a specific article. Without it, the claim would be lacking in meaning.

Accordingly, just as in *Sumitomo*, Andrews and Dapsalmon do not disclose the limitation of a papermaking or industrial fabric.

Applicants' attorneys also respectfully remind the Examiner that in order for a Section 102 rejection to stand, the prior art reference must contain all of the elements of the claimed invention. See *Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

Accordingly, because, as detailed above, the relied portions of Andrews fail to teach every claim element, the Section 102 rejections must fail as a matter of law. Therefore, Applicants respectfully request that the Section 102 rejections be withdrawn.

Additionally, in order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-84 (Fed. Cir. 1992), "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the § 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Applying the law to the instant facts, Applicants' attorneys respectfully submit that because Dapsalmon, either alone or in combination with the other cited references, fails to teach, suggest or motivate a skilled artisan to practice the instantly claimed invention, the § 103 rejections must fail as a matter of law. Further, "obvious to try" is not the standard upon which an obviousness rejection should be based. As "obvious to try" would be the only basis by which the obviousness rejection could stand and because there is no motivation found in the cited references to combine or modify the cited references in the manner suggested by the Examiner, it is respectfully submitted that the § 103 rejections must fail for this reason as well.

Accordingly, in addition to the reasons discussed above, it is submitted that for similar or somewhat similar reasons outlined in the previous Amendment, independent claims 1, 15 and 48 patentably distinguish over the relied upon portions of the cited references and are therefore allowable. Further, claims 2-4, 6 and 14 that depend from claim 1 and claims 16-18, 20 and 28 that depend from claim 15, are allowable as well.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are patentable over the prior art and an early and favorable consideration thereof is solicited. Accordingly, a Notice of Allowance is earnestly solicited.

Because a response to the Office Action of July 11, 2006 was filed with a two-month extension on December 11, 2006, it is believed that no additional extension-of-time fee is due. The Commissioner is authorized to charge any additional fees that may be required to Deposit Account No. 50-0320.

Respectfully submitted,
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